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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,112	08/28/2001	Thomas Marshall	1136.ACT2.NP	6920
7590	06/30/2004		EXAMINER FLANDRO, RYAN M	
Randall B. Bateman P O Box 1319 Salt Lake City, UT 84110-1319			ART UNIT 3679	PAPER NUMBER
DATE MAILED: 06/30/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/942,112

Applicant(s)

MARSHALL ET AL.

Examiner

Ryan M Flandro

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20011218.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1 – Figures 3 and 5

Species 2 – Figures 4, 6, 6A, 6B, 7, 7A and 7B

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, at least claim 10 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Randall Bateman on 6/17/04 a provisional election was made without traverse to prosecute the invention of Species 1, claims 1-22. Affirmation of this election must be made by applicant in replying to this Office action. Claim 23 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

3. Claims 1, 11, 19 and 20 are objected to because of the following informalities: (a) the last line of claim 1 recites a “facing **plate**” – this should be changed to --facing **strip**--; (b) the last line of claim 11 recites “openings disposed on opposite sides from **on** another” and should instead read --openings disposed on opposite sides from **one** another--; (c) the second line of claim 19 recites “a facing **plate**” – this should be changed to --facing **strip**--; and (d) the last two lines of claim 20 recite the term “**seem**” – this should be changed to --**seam**--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Pates (US 867,406).

- a. Claim 1. Pates shows a joint comprising a first plate **A**; a second plate **A**; and a facing strip **C** configured for engaging the first plate **A** and the second plate **A**, the facing strip **C** being bent so as slope outwardly toward the first plate **A** and the second plate **A** and contact the first plate **A** and the second plate **A** at lateral edges of the facing [strip?] **C** (see figures 1 and 3).
- b. Claim 2. Pates further shows the facing strip **C** further comprises at least one bracket **B** attached thereto for receiving a bolt **b** (see figures 1 and 3).
- c. Claim 3. Pates further shows the at least one bracket **B** comprises an opening for sliding a bolt **b** into the bracket **B** (see figures 1 and 3).
- d. Claim 4. Pates further shows the at least one bracket **B** comprises at least two brackets **B** each having an opening for receiving a bolt **b**, and wherein the openings on the at least two brackets **B** are disposed on opposite sides of the brackets **B** from one another (see figures 1 and 3).
- e. Claim 5. Pates further shows the facing strip **C** has walls extending rearwardly to the first plate **A** and the second plate **A** at an angle of about 12.5 degrees (see figure 3).
- f. Claim 6. Pates further shows [the] only portion of the facing strip **C** which touches the first plate **A** and the second plate **A** are the lateral edges (see figure 3).

- g. Claim 7. Pates shows and discloses a joint strip comprising a facing strip **C** having a bent central portion and walls having lateral edges extending away from the bent central portion; and at least one bracket **B** attached to the facing strip **C** for engaging a bolt **b** so as to hold the bolt **b** to the facing strip **C** (see figures 1 and 3).
- h. Claim 8. Pates further shows the walls extend rearwardly from the bent central portion at an angle of about 12.5 degrees (see figure 3).
- i. Claim 9. Pates further shows the at least one bracket **B** comprises a plurality of brackets **B**, each of the brackets **B** having an opening for receiving a bolt **b** and at least two of the brackets **B** having the opening on opposing sides thereof (see figure 3).
- j. Claim 10. Pates shows and discloses a joint strip for attaching a pair of steel plates **A** together, the joint strip comprising a facing strip **C** configured to engage a pair of steel plates **A**; and at least one bracket **B** attached to the facing strip **C** and having an opening for receiving the head of a bolt **b** and for holding the bolt **b** to the joint strip (see figures 1 and 3).
- k. Claim 11. Pates further shows the at least one bracket **B** comprises a plurality of brackets **B** having openings, and wherein at least two of the brackets **B** having openings disposed on opposite sides from [one] another (see figure 3).
- l. Claim 12. Pates further shows the facing strip has two walls disposed about 155 degrees from one another (see figure 3).
- m. Claim 13. Pates shows a joint strip for attaching a pair of steel plates **A** together, the joint strip comprising a facing strip **C** defining a pair of sloped walls extending outwardly and rearwardly from a central portion (see figure 3).

- n. Claim 14. Pates further shows a plurality of brackets **B** fixedly attached to the facing strip **C**, each of the brackets **B** being configured to receive a bolt **b** (see figure 3).
- o. Claim 15. Pates further shows at least two of the brackets **B** have holes for receiving a bolt **b**, the holes being disposed on opposing sides of the brackets **B** (see figure 3).
- p. Claim 16. Pates shows a method comprising disposing first and second plates **A** adjacent one another; placing a facing strip **C** over the opening so that the facing strip **C** slopes rearwardly and outwardly into engagement with the first and second plates **A** to secure the plates **A** together (see figure 3). Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification, it can be assumed the device will inherently perform the same process. *In re King*, 802 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986).
- q. Claim 17. Pates further shows the facing strip **C** has lateral edges **c'** and wherein the only portion of the facing strip **C** which engage the first and second plates **A** is the lateral edges **c'** (see figure 3).
- r. Claim 18. Pates further shows the facing strip **C** has a plurality of brackets **B** attached thereto, and wherein the method further comprises removably positioning bolts **b** in the brackets **B** (see figure 3).

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- s. Claim 19. Pates further shows selecting a facing [strip?] **C** whereon at least two of the brackets **B** have openings for receiving the bolts **b**, and wherein the openings are disposed on opposing sides of the brackets **B** (see figure 3).
6. Claims 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Bateman (US 5,822,936).
- a. Claim 20. Bateman shows a method for forming a section of a bullet trap, the method comprising placing first and second plates **310** adjacent one another so as to leave a seam therebetween; selecting a joint strip having a facing strip **320** and a bracket **330** attached to the facing strip **320** for holding an end of a bolt **322**; and covering the [seam] between the plates with the facing strip **320** so that the bolt **b** extends through the [seam] (see figure 8).
  - b. Claim 21. Bateman further shows selecting a joint strip having a facing strip **320** which is beveled to have two rearwardly extending walls **314** terminating at lateral edges (see figure 8).
  - c. Claim 22. Bateman further shows engaging the lateral edges of the facing strip **320** with the first and second plates **310** so that the only portion of the facing strip **320** which touches the first and second plates **310** is the lateral edges (see figure 8).



***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan M Flandro whose telephone number is (703) 305-6952. The examiner can normally be reached on 8:30am - 5:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RMF  
June 21, 2004

  
John R. Cottingham  
Patent Examiner